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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/531,308

04/13/2005

Hiroshi Kajimaru

0020-5368PUS1

6336

2292 7590 12/27/2006
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EXAMINER

MESH, GENNADIY

ART UNIT

PAPER NUMBER

1711

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
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3 MONTHS

12/27/2006

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 12/27/2006.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/531,308

Applicant(s)

KAJIMARU ET AL.

Examiner

Gennadiy Mesh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Preliminary Amendment filed on March 29,2006 is acknowledged. Claim 3 is cancelled by Applicant. Claims 1-2 and 4-9 are pending in Application.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

1.1. Claims 1-2 and 4-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kajimaru(US 2002/0061959 - now US Patent 6,818,699).

Regarding Claims 1 and 2 Kajimaru discloses aqueous polyester resin dispersion composition comprising, polyester resin particles in the amount from 1- 60 % by mass (see lines 55 – 65,column 6), having acid value of 8 to 40 mg KOH/g and average molecular weight more than 9000, basic compound(see abstract) and water, in the amount more than 10 % by mass (see Table 2). Composition contains polyester particles with particle size less than 400 nm(see Table 3). Composition does not contain surfactant.

Resins with Acid value of 8 mg KOH/g will contain resins with Acid value less than 8 mg KOH/g due to precision (accuracy) of analytical procedure of the determination of acid value and thus will meet limitation of Claim 1.

Regarding Claim 4 see [0043].

Regarding Claim 5 see [0023].

Regarding Claim 6 see [0021].

Regarding Claims 7 and 8 Kajimaru discloses production process of obtaining aqueous dispersion of polyester resin(see [0060] – [0066]), wherein resin mixed with organic solvent and basic compound in water at preferable temperature less than 40°C with following step of removing organic solvent(see [0067]).

Regarding limitation of Claim 9: amount of basic compound(see[0050]) disclosed by Kajimaru as 0.2 to 2 times more than equivalent amount of the carboxyl group satisfies value of F in formula (1).

1.2. Claims 1-2 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Uno (EP 1 202 122).

Regarding Claims 1 and 2 Uno discloses aqueous polyester resin dispersion composition comprising, polyester resin particles in the amount of 50 % by mass (see line 53, page 11), having acid value of 5 - 100 mg KOH/g (see line 55,page 3) and average molecular weight from 10,000 to 500,000 (see line 45, basic compound(see abstract) and water, in the amount more than 10 % by mass. Composition contains polyester particles with particle size in a range from 100 nm to 10 micron(see line 25,page 7). Composition does not contain surfactant.

Regarding Claims 4-6 Uno discloses that polyester resin can be prepared by polymerization of polybasic acid [0021], wherein polybasic acid can be tri- or four-functional [0022] and/or aromatic (see line 4,page 5).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1- 2 and 4-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kajimaru(US 2002/0061959) in view of Uno (EP 1 202 122).

As stated above Kajimaru discloses aqueous dispersion of polyester resins with acid value of 8 to 40 mg KOH/g.

However, as also stated above Uno discloses aqueous dispersion of polyester resins with preferable acid value in a range from 5 mg KOH/g in order to improve stability of the polyester resin in dispersion (see [0017]).

Therefore, it would have been obvious to one of ordinary of skill in the art to use polyester resin discloses by Uno in composition taught by Kajimaru in order to obtain aqueous dispersion of polyester resin with improved stability.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to

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be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

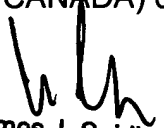
Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-2 and 4-9 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. US 6,818,699 in view of Uno(EP 1 202 122). As it shown above Applicant's claimed subject mater is obvious modification of claims 1-6 of U.S. Patent No. US 6,818,699.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gennadiy Mesh whose telephone number is (571) 272 2901. The examiner can normally be reached on 8a.m - 4 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272 1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700

 12/15/06